

01-30-02

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PTO/SB/50 (02-01)

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REISSUE PATENT APPLICATION TRANSMITTAL

Address to:

Assistant Commissioner for Patents
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Washington, DC 20231

Attorney Docket No.

Re10030i

First Named Inventor

Harold Kohn

Original Patent Number

58,773,475

Original Patent Issue Date
(Month/Day/Year)

06/30/1998

Express Mail Label No.

EV010535328US

APPLICATION FOR REISSUE OF:

(Check applicable box)



Utility Patent



Design Patent



Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)

1. ☒ Fee Transmittal Form (PTO/SB/56)
(Submit an original, and a duplicate for fee processing)
2. ☐ Applicant claims small entity status. See 37 CFR 1.27.
3. ☒ Specification and Claims in double column copy of patent
format (amended, if appropriate)
4. ☐ Drawing(s) (proposed amendments, if appropriate)
- ☒ Reissue Oath/Declaration (original or copy)
(37 C.F.R. § 1.175) (PTO/SB/51 or 52)
- ☒ Power of Attorney
- Original U.S. Patent currently assigned? ☒ Yes ☐ No
(If Yes, check applicable box(es))
- ☒ Written Consent of all Assignees (PTO/SB/53)
- ☒ 37 C.F.R. § 3.73(b) Statement
(PTO/SB/96)
- ☐ CD-ROM or CD-R in duplicate, Computer Program (Appendix)
or large table
- Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all of the following are necessary)
- a. ☐ Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
i. ☐ CD-ROM (2 copies) or CD-R (2 copies); or
ii. ☐ paper
- c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

10. ☐ Statement of status and support for all changes
to the claims. See 37 CFR 1.173 (c).
11. ☐ Original U.S. Patent for surrender
- ☐ Ribbioned Original Patent Grant
- ☐ Statement of Loss (PTO/SB/55)
12. ☐ Foreign Priority Claim (35 U.S.C. 119)
(if applicable)
13. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS
Citations
14. ☐ English Translation of Reissue Oath/Declaration
(if applicable)
15. ☐ Preliminary Amendment
16. ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
17. Other: Letter

18. CORRESPONDENCE ADDRESS



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NAME (Print/Type)

Mark J. Cohen

Registration No. (Attorney/Agent)

32,211

Signature

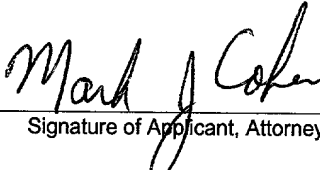
Mark J. Cohen

Date

1/28/02

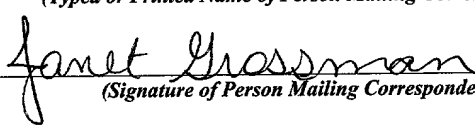
Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Reissue, Washington, DC 20231.

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REISSUE APPLICATION FEE TRANSMITTAL FORM						Docket Number Rei10030		
Claims as Filed - Part 1								
Claims in Patent		Number Filed in Reissue Application	(3) Number Extra	Small Entity		Other than a Small Entity		
				Rate	Fee	Rate	Fee	
(A) 13	Total Claims (37 CFR 1.16(j))	(B) 13	**** 0 =	x \$ 9 =	\$0	or	x \$ 18 = \$0	
(C) 1	Independent claims (37 CFR 1.16(i))	(D) 1	* 0 =	x \$ 42 =	\$0		x \$ 84 = \$0	
Basic Fee (37 CFR					\$370			\$740
Total Filing Fee					\$370		\$740	
Claims as Amended - Part 2								
		(1) Claims Remaining After Amendment	(2) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity		Other than a Small Entity	
					Rate	Fee	Rate	Fee
Total Claims (37 CFR 1.16(j))		***	MINUS **	= 0	x \$ 9 =	\$0	x \$ 18 =	\$0
Independent Claims (37 CFR 1.16(i))		***	MINUS *****	= 0	x \$ 42 =	\$0	x \$ 84 =	\$0
Total Additional Fee					\$0	OR	\$0	
<p>* If the entry in (D) is less than the entry in (C), Write "0" in column 3.</p> <p>** If the "Highest Number of Total Claims Previously Paid For" is less than 20, Write "20" in this space.</p> <p>*** After any cancellation of claims.</p> <p>**** If "A" is greater than 20, use (B - A); if "A" is 20 or less, use (B - 20).</p> <p>***** "Highest Number of Independent Claims Previously Paid For" or Number of Independent Claims in Patent (C).</p> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.</p> <p><input checked="" type="checkbox"/> Please charge Deposit Account No. <u>19-3886/RCT</u> in the amount of <u>\$740</u>. A duplicate copy of this sheet is</p> <p><input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. <u>19-3886/RCT</u>. A duplicate copy of this sheet is enclosed.</p> <p><input type="checkbox"/> A check in the amount of \$ _____ to cover the filing / additional fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p style="text-align: center;">WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <div style="display: flex; justify-content: space-between; margin-top: 20px;"> <div style="width: 40%;"> <p>January 28, 2002</p> <p>_____ Date</p> </div> <div style="width: 50%; text-align: center;">  <p>_____ Signature of Applicant, Attorney or Agent of Record</p> <p>Mark J. Cohen _____ Typed or printed name</p> </div> </div>								

01-30-02

A/REISSUE

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)			Docket No. REI10030
Applicant(s): Harol Kohn			
Serial No. US Patent 5,773,475	Filing Date Issued 6/30/98	Examiner S. Kumar	Group Art Unit 1209
Invention: ANTICONVULSANT ENANTIOMERIC AMINO ACID DERIVATIVES			
I hereby certify that the following correspondence:			
<div style="border: 1px solid black; padding: 5px;">New Reissue Application</div>			
<i>(Identify type of correspondence)</i>			
is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on			
<div style="text-align: center;"><u>January 28, 2002</u> <i>(Date)</i></div>			
<div style="text-align: center;"><u>Janet Grossman</u> <i>(Typed or Printed Name of Person Mailing Correspondence)</i></div>			
<div style="text-align: center;"> <i>(Signature of Person Mailing Correspondence)</i></div>			
<div style="text-align: center;"><u>EV010535328US</u> <i>("Express Mail" Mailing Label Number)</i></div>			
Note: Each paper must have its own certificate of mailing.			

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Harold Kohn

Examiner: S. Kumar

Serial No.: 08/818,688

Art Unit: 1209

Filed: March 17, 1997

Docket: REI-10030

Reissue of Patent No.: 5,773,475

Issued: June 30, 1998

For: ANTICONVULSANT ENANTIOMERIC
AMINO ACID DERIVATIVES

Dated: January 28, 2002

Assistant Commissioner for Patents
Washington, DC 20231

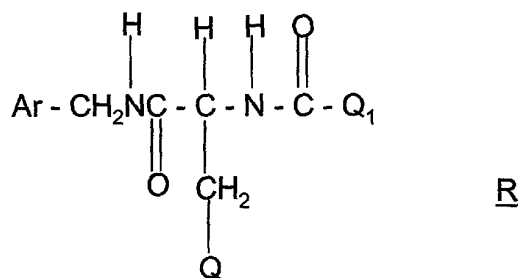
LETTER

Sir:

This re-issue application is being filed to perfect the claim of priority for a provisional application in which the claim of priority was made during the pendency of the underlying application for the '475 patent.

The facts are outlined in the Declaration by the inventor, Dr. Harold Kohn, (hereinafter referred to as the "Kohn Declaration"), filed concurrently herewith, and are summarized hereinbelow.

A provisional application was filed on March 15, 1996 and was assigned Serial Number U.S.S.N. 60/013,522 (hereinafter "provisional application"). The application was directed, inter alia, to a compound in the R configuration having the formula:



wherein

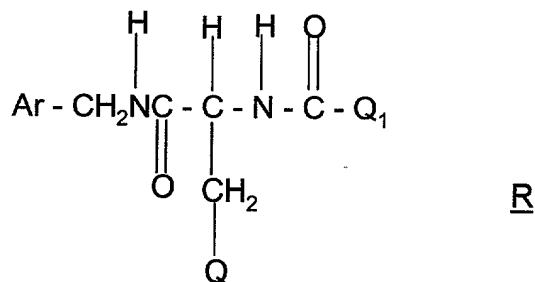
Ar is phenyl which is unsubstituted or substituted with at least one halo group;

Q is lower alkoxy; and

Q₁ is methyl.

It was also directed, inter alia, to a method of treating central nervous system disorders in an animal comprising administering to said animal in need thereof an anti-convulsant effective amount of said compound. See Kohn Declaration, Paragraph 11.

The U.S. patent application based thereon, which was assigned Serial Number 08/818,688 (hereinafter "'688 application"), was also directed to a compound in the R configuration having the formula:



wherein

Ar is phenyl which is unsubstituted or substituted with at least one halo group;

Q is lower alkoxy; and

Q₁ is methyl.

The utility application was also directed, inter alia, to a method of treating central nervous system disorders in an animal comprising administering to said animal in need thereof an anti-convulsant effective amount of said compound. See Kohn Declaration, Paragraph 6.

The subject matter in the '688 application is directed to the same compounds and to the same uses as described in the underlying provisional application. Thus, the subject matter

of the '688 application was described in the underlying provisional application in compliance with the requirements of 35 U.S.C. §112, first paragraph.

The first sentence of the '688 application as filed, claimed priority from the provisional application. It stated:

This application claims priority from U.S. Provisional Application No. 60/013,522 filed March 15, 1996.

See Exhibit B attached to the Kohn Declaration. The '688 application was filed on March 17, 1997, which was the first business day after the one-year anniversary date of the filing of the provisional application of March 15, 1997, which fell on a Saturday.

In accordance with 35 U.S.C. §119(e), the '688 application was timely filed, and thus is entitled to the priority of the provisional application.

35 U.S.C. §119(e) reads, in part, as follows:

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director...

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional

application shall be extended to the next succeeding secular or business day...

As originally filed, the '688 application had reference to the earlier filed provisional application. Inasmuch as the 12 month date of the filing of the provisional application i.e., March 15, 1997, fell on a Saturday in 1997, according to 35 U.S.C. §119(e)(3) the period of pendency of the provisional application was extended to the next succeeding secular or business day, i.e., March 17, 1997, and thus under the statute, when the application was filed on March 17, 1997, it was copending at the time of the filing thereof with the provisional application. Thus, the '688 application should be accorded the priority of the provisional application.

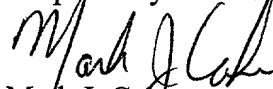
Although the amendment to 35 U.S.C. §119(e), which added, inter alia, 35 U.S.C. §119(e)(3), took effect on November 29, 1999, which was subsequent to the issuance of the '475 patent, attention is directed to the American Inventors Protection Act of 1999, Pub. L. 106-113, Div. B, §1000(a)(9) [Title IV of the "Intellectual Property and Communications Omnibus Reform Act of 1999", §4801(d)], 113 Stat. 1536, 1501A-589, (1999). This is reprinted, in part, with the appropriate annotations, in the Historical and Statutory Notes of 35 U.S.C.A. §119 (West Supp. 2001), which reads as follows:

"The amendments made by this section [amending this section and section 111 of this title] shall take effect on the date of the enactment of this Act [Nov. 29, 1999, which is the date of enactment of Pub. L. 106-113, 113 Stat. 1501, which in Div. B. §1000(a)(9), enacted into law this act as an Appendix] and shall apply to any provisional application filed on or after June 8, 1995, except that the amendments made by subsection (b) and (c) [amending subsec. (e) of this section] shall have no effect with respect to any patent which is the subject of litigation in an action commenced before such date of enactment."

Accordingly, the amendment to 35 U.S.C. §119(e) applies to any provisional application filed on or after June 8, 1995, with the exception noted above. Inasmuch as the language of §4801(d) of Title IV refers to a patent and indicates that the only exception is a patent which is the "subject of litigation in an action commenced before such date of enactment", it is apparent that 35 U.S.C. §119(e) is applicable to an issued patent, with the exception noted hereinabove based on a provisional application filed on or after June 8, 1995. Moreover, the '688 application was filed on March 17, 1997, which is subsequent to the June 8, 1995 date. Inasmuch as the '475 patent was not involved in any litigation in an action commenced before the "date of enactment" or otherwise, the amendment to 35 U.S.C. §119(e) applies to the present patent. Accordingly, in accordance with 35 U.S.C. §119(e), the '688 application is entitled to the priority date of the provisional application. Thus, it is respectfully requested that the '475 patent be accorded the priority of U.S.S.N. 60/013,522.

In the event that additional fees are associated with this filing, the Commissioner is authorized to charge Deposit Account No. 19-3886/RCT. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



Mark J. Cohen

Registration No. 32,211

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MJC:lf